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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/780,197 | 02/17/2004 | Chu-Kuo Wang | CFP-1773~1 (15722/436CIP) | 9919 |
| 23595 | 7590 | 03/22/2005 | EXAMINER | |
| NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402 | | | DURAND, PAUL R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3721 | |

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/780,197 | Applicant(s) WANG ET AL. | |
| | Examiner Paul Durand | Art Unit 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on 12/20/2004. These drawings are accepted.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cast et al (US 3,397,617) in view of Schadlich et al (US 4,515,303).

In regard to claim 2, Cast discloses the invention substantially as claimed including a magazine 12, for holding nails 13, housing 2, containing a cup shaped piston 204, which functions as a mandrel and a security device, an insert secured to the housing comprised of head 225 with friction element 226 which secures the piston coming from the punching position (see Figs 1-3 and C4,L48 – C6,L49). What Cast does not disclose is the use of a solenoid to power the tool. However, Schadlich teaches that it is old and well known in the art to provide a nailer or stapler, with magazine 17, spring 11 and a solenoid 2, with a cup shaped mandrel in the form of armature 4 for the purpose of electrically driving a tool (see Fig.1 and C2,L44 – C3,L20). Furthermore, while both Cast and Schadlich teach of an integral cup and mandrel assembly, the examiner asserts that it would have been obvious to one having ordinary

skill in the art at the time the invention was made to provide a separate cup receiving and mandrel means; since it has been held that constructing a formerly integral structure into various elements involves only routing skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Cast with the solenoid driving means as taught by Schadlich for the purpose of electrically driving a tool.

In regard to claims 3 and 4, Cast discloses the invention substantially as claimed including a ring in the form of hold element 226 arranged on the head 225 (Figs. 1-3). However, while the modified invention of Cast does not disclose the use of a groove to hold an o-ring, the examiner asserts that the hold element of the modified invention is effectively an integral o-ring, not needing a groove to sit in, and as such is equivalent in the art.

In regard to claims 5 and 6, the modified invention of Cast discloses the invention as claimed except for the use of two grooves and two rings. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Cast with a plurality of rings and grooves since it has been held that mere duplication of parts of the essential; working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Cast with the plurality of grooves and rings for the purpose of reducing tool recoil.

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4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurer (US 3,969,988) in view of Schadlich et al (US 4,515,303).

Maurer discloses the invention substantially as claimed including a magazine 13, for holding nails, housing 1, containing a piston 8, which functions as a mandrel and a security device, an insert secured to the mandrel comprised of head 29 with friction element in the form of shoulder 32 which secures the piston coming from the punching position (see Fig.2 and C4,L3-62). What Maurer does not disclose is the use of a solenoid to power the tool. However, Schadlich teaches that it is old and well known in the art to provide a nailer or stapler, with magazine 17, spring 11 and a solenoid 2, with a cup shaped mandrel in the form of armature 4 for the purpose of electrically driving a tool (see Fig.1 and C2,L44 – C3,L20). Furthermore, while both Maurer and Schadlich teach of an integral cup and mandrel assembly, the examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a separate cup receiving and mandrel means, since it has been held that constructing a formerly integral structure into various elements involves only routing skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Cast with the solenoid driving means as taught by Schadlich for the purpose of electrically driving a tool.

5. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cast et al (US 3,397,617) in view of Schadlich et al (US 4,515,303).

In regard to claim 7, Cast discloses the invention substantially as claimed including a magazine 12, for holding nails 13, housing 2, containing a cup shaped piston 204, which functions as a mandrel and a security device, an insert secured to the housing comprised of head 225 with friction element 226 which secures the piston coming from the punching position (see Figs 1-3 and C4,L48 – C6,L49). What Cast does not disclose is the use of a solenoid to power the tool. However, Schadlich teaches that it is old and well known in the art to provide a nailer or stapler, with magazine 17, spring 11 and a solenoid 2, with a cup shaped mandrel in the form of armature 4 for the purpose of electrically driving a tool (see Fig.1 and C2,L44 – C3,L20). Furthermore, while both Cast and Schadlich teach of an integral cup and mandrel assembly, the examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a separate cup receiving and mandrel means, since it has been held that constructing a formerly integral structure into various elements involves only routing skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Still furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Cast with the insert and the cap reversed, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Cast with the solenoid driving means as taught by Schadlich for the purpose of electrically driving a tool.

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In regard to claims 8 and 9, Cast discloses the invention substantially as claimed including a ring in the form of hold element 226 arranged on the head 225 (Figs. 1-3). However, while the modified invention of Cast does not disclose the use of a groove to hold an o-ring, the examiner asserts that the hold element of the modified invention is effectively an integral o-ring, not needing a groove to sit in, and as such is equivalent in the art.

In regard to claims 10 and 11, the modified invention of Cast discloses the invention as claimed except for the use of two grooves and two rings. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Cast with a plurality of rings and grooves since it has been held that mere duplication of parts of the essential; working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Cast with the plurality of grooves and rings for the purpose of reducing tool recoil.

Response to Arguments

6. Applicant's arguments with respect to claims 2-11 have been considered but are moot in view of the new ground(s) of rejection.

This action is being made non-final.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
March 7, 2005



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700